

**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES**

First Named Inventor : Steven Jeremy Carriere
Serial No. : 09/531,743
Filed : March 21, 2000
Art Unit : 3627
Confirmation No. : 7120
Examiner : Shaawat, M.
Title : SYSTEM AND METHOD FOR FUNNELING USER
RESPONSES IN AN INTERNET VOICE PORTAL
SYSTEM TO DETERMINE A DESIRED ITEM OR
SERVICE
Attorney Docket No. : QUAC0006

October 19, 2009

MAIL STOP: REPLY BRIEF - PATENTS

Honorable Commissioner of Patents & Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Applicant's Reply Brief concerning the above-captioned patent application follows.

STATUS OF THE CLAIMS

As to all Claims in the specification, the status is as follows:

Claims 1-27, 31 and 32 have been previously withdrawn. Claims 28-30 and 33-35 are rejected. The rejection of each of claims 28-30 and 33-35 is being appealed.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 28-30 and 33-35 were finally rejected in an Office Action dated December 2, 2008 ("Final Action"). The grounds of rejection to be reviewed on appeal are:

- Whether Claim 28 complies with the written description requirement as per 35 U.S.C. § 112, first paragraph;
- Whether Claim 28 is indefinite for failing to particularly point out and distinctly claims the subject matter that Appellant regards as the invention, as per 35 U.S.C. § 112, second paragraph;
- Whether Claims 28-30 and 33-35 are patentable under 35 U.S.C. § 103(a) over a combination of United States patent no. 5,799,063 to Krane, *et al.* ("Krane") and United States patent no. 6,400,806 to Uppaluru, *et al.* ("Uppaluru").

ARGUMENTS

Claim 28 Complies With the Written Description Requirement as per 35 U.S.C. § 112, First Paragraph.

Claim 28 is rejected under 35 U.S.C. § 112, first paragraph for not complying with the written description requirement. More specifically, the Office states that the Claim element “unassisted by voice extensions and enhancements to said HTML” is not described in the specification in such a way as to reasonably convey to one skilled in the art that Appellant had possession of the Claimed Invention at the time of filing. The Examiner cited MPEP 2173.05 (i) as authority for this position.

As in the Final Action, The Office notes at page 3, item 2, lines 11-12, that the mere absence of a positive recitation is not basis for exclusion. Appellant, however, pointed out in the Appeal Brief that the very same section cited by the Examiner also states that “a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support”(emphasis added). Appellant also pointed out that MPEP § 2163 states that “newly added claim limitations must be supported in the specification through express, implicit or inherent disclosure” (emphasis added). Accordingly, there is ample authority for the position that there is no requirement that a “negative limitation” must be literally or explicitly described in the disclosure.

In support of the position that the Specification-as-filed describes, at least inherently or implicitly, the Claim element “conducting an Internet search of HTML non-voice sources for prescribed types of information pertaining to the chosen bottom-level attribute value and, unassisted by voice extensions and enhancements to said HTML, audibly providing resultant information to the user via the telephone call . . .”, Appellant, at pages 9-10 of the Appeal Brief offered the following:

- At page 26, lines 21 to page 29, line 10, the Specification-as-filed describes the extraction of data from web pages;
- In particular, page 27, line 24 to page 28, line 1 shows a block of conventional HTML code, completely free of voice recognition extensions or enhancements.

Thus, even without any special enhancements or extensions, the voice portal is capable of extracting data from the HTML and rendering it as speech.

Additionally, page 29, lines 24-49 describes that a “page” includes a “user interface screen or similar arrangement which can be viewed by a user of the diagnostic system, such as screens providing graphical or textual representations of data, messages reports and so forth. Moreover, such pages may be defined by a markup language or a programming language such as Java, perl, java script, or any other suitable language” (emphasis added). Accordingly, the “pages” from which data is extracted for being rendered as speech contain only information that would otherwise be rendered visually. Appellant argued that it was therefore incorrect that the original disclosure provides no basis for the Claim element “. . . unassisted by voice extensions and enhancements to said HTML.”

The Office disagreed with Appellant’s argument, stating in its Response that the portions relied upon by Appellant “are mere examples for clarification which are the only way to perform the invention [sic].” Appellant agrees with the Office’s characterization of the citations as examples of how the invention is performed, although Appellant does not agree with the Office’s dismissal of their descriptive value.

An adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention. MPEP § 2163(II)(3)(a), referring to *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000). Starting at page 27, line 10 of the Specification-as-filed and continuing through page 28, line 24, an embodiment of an approach for extracting data from “web pages” (27:11) is described. At page 27, line 24 to page 28, line 1, the Specification shows a block of HTML code. As Appellant has previously explained, the HTML is conventional, lacking any voice extensions or enhancements. The remainder of the description of the embodiment explains how the principles of the invention are applied to the section of HTML code depicted in order to extract information that was originally intended only for visual display from the HTML, for rendering as speech by the voice portal.

Because, as the Office states, the HTML code section is provided as an example of how the invention works, the example coupled with the careful, stepwise description of the exemplary embodiment readily conveys to the ordinarily-skilled practitioner that Appellant had possession of a method wherein data is extracted from HTML pages. Because the illustrative example contains data that is intended only for visual display and because the HTML code is free of any voice extensions or other enhancements, the ordinarily-skilled practitioner would readily understand that Appellant had at least inherently and/or implicitly described a method that performed such data extraction unassisted by voice extensions or other enhancements, such that the ordinarily-skilled practitioner would know that Appellant has possession of the inventive method.

Therefore Appellant respectfully disagrees with the Office that the specification does not satisfy the requirements of 35 U.S.C. § 112, first paragraph. In fact, it is Appellant's position that the Office's statement that the HTML code on pages 27-28 constitutes an example of how the invention is performed constitutes nothing less than an admission that the citations from the Specification-as-filed do provide a description of the subject matter in question that is completely consistent with the statutory requirements. The fact that the Office denigrates the code block as a "mere" example in no way diminishes the potency of the Office's admission. Thus, the Office places itself in the awkward position of admitting that something is so, while, at the same time, asserting that what is admitted to, is not so.

In regard to the page 29 citation, the Office asserts that the citation contradicts the claim element "conducting an Internet search of HTML non-voice sources for prescribed types of information pertaining to the chosen bottom-level attribute value and, unassisted by voice extensions and enhancements to said HTML, audibly providing resultant information to the user via the telephone call." Appellant respectfully disagrees. As Appellant stressed by underlining above, the citation describes that "such pages may be defined by a markup language or a programmable language such as java, perl, java script or any other suitable language." It is beyond dispute that the conjunction "or" is used to connect expressions that represent alternatives. The citation describes that the pages may be markup language or they may be java or perl or java script or any other suitable

language. In other words, the citation is describing a series of alternatives. "If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims." MPEP § 2173.05(i), referring to *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977). Thus, in describing a series of alternatives in the specification that include pages made from a markup language, or other programming languages such as JAVA, and including the element "unassisted by voice extensions and enhancements to said HTML" in a Claim, Appellant is excluding from the Claims the alternatives in the series that involve programming languages such as JAVA, *etc.*, which, as above, is entirely permissible. Such exclusion is not intended to be a disclaimer of the excluded subject matter nor should such exclusion be taken as intent to forsake Claim scope. Appellant expressly reserves the right to pursue patent protection for the excluded subject matter in one or more future submissions to the Office.

Accordingly, Appellant disagrees with the Office's assertion that the citation contradicts the language of Claim 28.

The Office also asserts that the Claim element "unassisted by voice extensions and enhancements to said HTML" appears to be a negative limitation used to overcome the prior art. Even if the Office's assertion were correct, and Appellant makes no such admission, the proper inquiry under 35 U.S.C. § 112, first paragraph is whether the claimed subject matter is described in the Specification in such a way that a person skilled in the art would recognize that the inventor had possession of the claimed invention. Thus, Appellant's motive in adding the Claim element is immaterial to the analysis.

In view of the foregoing the subject rejection under 35 U.S.C. § 112, first paragraph is deemed improper. Appellant also notes that the Office has completely failed to respond to or comment on any of the remaining points raised by Appellant in the Appeal Brief regarding the rejection under 35 U.S.C. § 112, first paragraph. Because the Office has failed to comment on the remaining points of Appellant's argument, such points remain unrebutted by the Office. It is Appellant's position that such failure to rebut important points of Appellant's argument constitutes an admission by the Office that the points are valid.

Claim 28 Particularly Points Out and Distinctly Claims the Subject Matter that Appellant Regards as the Invention, and Is therefore Definite as per 35 U.S.C. § 112, Second Paragraph.

Claim 28 was also rejected under 35 U.S.C. § 112, Second Paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that Appellant regards as the Invention. In view of the foregoing discussion, Appellant respectfully posits that the subject rejection is improper.

Uppaluru Does Not Teach or Suggest “Conducting an Internet Search of HTML Non-Voice Sources for Prescribed Types of Information Pertaining to the Chosen Bottom-Level Attribute Value and, Unassisted By Voice Extensions and Enhancements to said HTML, Audibly Providing Resultant Information to the User Via the Telephone Call.”

Claim 28

Claims 28-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of United States patent no. 5,799,063 to Krane, *et al.* (“Krane”) and United States patent no. 6,400,806 to Uppaluru, *et al.* (“Uppaluru”). Appellant respectfully disagrees.

Appellant first notes that, although Appellant took great pains to respond to every point of the rejection in the Final Action, carefully citing portions of the references in support of the points made, in its Answer to the Appeal Brief, the Office has simply repeated, word for word, the rejection of the Final Action, completely ignoring the points of Appellant’s arguments. Because the Office has failed to respond to the Arguments presented by Appellant in the Appeal Brief concerning Uppaluru, Appellant’s Arguments remain unrebutted, thus constituting an admission by the Office that Applicant’s Arguments concerning the Uppaluru teachings are valid.

In fact, the Office explicitly indicates its agreement with Appellant’s interpretation of the Uppaluru teachings. At page 10 (Argument C) of the Answer, the Office states: “The invention (*i.e.* Uppaluru) features a set of web pages containing information formatted using MIME and HTML and hypertext markup language standards (sic) with extensions for voice information access and navigation”(parenthetical expression and emphasis added). Thus, the Office agrees with Appellant’s interpretation of Uppaluru as teaching that standard HTML is extended in order to render non-voice HTML as speech. Yet, in view of its explicit agreement with Appellant’s interpretation of Uppaluru, it somehow asserts that Uppaluru does not teach what it agrees that Uppaluru teaches.

The Office also, again, cites Uppaluru, col. 12, lines 3-5 as teaching or suggesting

“Audibly providing resultant information (from a search of HTML non-voice sources) to the user via the telephone call, unassisted by voice extensions and enhancements to said HTML” (parenthetic expression added). Appellant notes again that the Office provides no explanation or analysis of the application of the citation to the Claim language.

Appellant has already exhaustively discussed the col. 12 citation and notes that the Office has completely failed to respond to any of the points in the Appeal Brief found at least at page 16, last 2 lines to page 17, line 16. The citation discusses playing email for a user using text-to-speech conversion. However, as Appellant pointed out in the Appeal Brief, the text-to-speech conversion only occurs within the context of, and can only be accessed from the “voice web.” As Appellant pointed out, playing emails as audio within the extremely limited scenario of a “personal voice web” does not disclose or suggest “Conducting an internet search of HTML non-voice sources for prescribed types of information pertaining to the chosen bottom-level attribute value and, unassisted by voice extensions and enhancements to said HTML, audibly providing resultant information to the user via the telephone call.”

Appellant also notes that the citation provides no details whatsoever of the text-to-speech conversion. However, at col. 8, lines 32-36, immediately following a paragraph providing a description of the voice tags in HVML that are necessary for rendering text information as speech, it is described, “Combining these tags, publishers can compose and present: . . . (ii) voice prompts generated using text-to-speech technology.” In other words text-to-speech conversion, within the “voice web”, requires the use of HVML tags. There is nothing in the col. 12 citation that indicates that the text-to-speech conversion there mentioned is any different from the tag-dependent text-to-speech conversion described at col. 8. lines 32-36. The Office again cites col. 7, this time, lines 4-46, again without explanation or analysis of how the citation is being applied to the Claim language. Again, although Appellant discussed the col. 7 teachings extensively, the Office withholds comment or rebuttal. Lines 4-8 deal with voice forms, voice web pages that are fill-able forms. They have nothing to do with “Conducting an internet search of HTML non-voice sources for prescribed types of information pertaining to the chosen bottom-level attribute

value and, unassisted by voice extensions and enhancements to said HTML, audibly providing resultant information to the user via the telephone call” and therefore contribute nothing additional to the discussion of the subject rejection.

Lines 10-46 are nothing but a description of HVML that has been thoroughly discussed by Appellant at least at page 15, line 5 to line 17, page 18, line 16 to page 19, line 17. Again, Appellant notes that the Office provides no explanation or analysis of its application of the citation to the Claim language, and completely fails to respond to Appellant’s comments and points raised in the Appeal Brief. As Uppaluru makes very clear, HVML web pages, contain voice features that are not found in conventional, non-voice HTML. As Uppaluru puts it, “Voice web pages 103 consist of HTML pages that have been extended with Hyper Voice Markup Language” (emphasis added), Additionally, Uppaluru describes at col. 8, lines 16-30:

HVML Presentation. Presentation of voice information is accomplished primarily by the voice tag. The voice tag has a type attribute which specifies the type of voice information to be presented. If the type attribute has the file value, the voice information is obtained from a voice file specified by its URL. If the type attribute has the text value, the voice information is synthesized from the specified text. If the type attribute has number, ordinal, currency, date, or character value, then the voice information is generated by concatenating voice fragments from a pre-recorded indexed system voice file. If the type attribute has the stream value, then the voice information is obtained from the voice stream specified by its URL. Composition of several voice elements into a seamless voice string is accomplished by the voice-string tag (emphasis added).

Thus, Uppaluru clearly describes that HVML includes voice extensions in order to present voice information, and that, in order to render text as spoken information, voice tags are necessary.

The Office also cites col. 2, lines 25-46. However the subject citation is merely taken from the Summary and constitutes language that Appellant has previously

discussed in detail.

The Office also cites col. 24, lines 15-25 as teaching or suggesting: "Conducting an internet search of HTML non-voice sources for prescribed types of information pertaining to the chosen bottom-level attribute value and, unassisted by voice extensions and enhancements to said HTML, audibly providing resultant information to the user via the telephone call." The col. 24 citation is from the Appendix that constitutes the HVML specification. Again, Appellant notes the lack of explanation or analysis of how the Office is applying the citation to the Claim language. In this case, the Office's intent is completely opaque. The citation describes the embedding in an HTML page of links to external files. The external file, can be, for example a .wav file. However, in the absence of any explanation from the Office, the relevance of the citation to the subject issue is not at all clear. In fact, it appears to have nothing to do with the subject issue.

The present rejection of Claim 28 is improper because the Office has failed to show that the combination teaches or suggests each and every element of Claim 28. As Appellant previously asserted in the Appeal Brief, Uppaluru explicitly teaches away from the subject matter of Claim 28. Again, as Appellant has already pointed out, Uppaluru, at least at co. 7, lines 11-33 takes great pains to distinguish voice web pages from conventional pages, discussing the shortcomings of conventional HTML pages and explaining why they are unsuitable for telephone users. Additionally, Appellant notes that the Office, in large part, appears to agree with Appellant's interpretation of the Office's own citations from Uppaluru, and yet, the Office somehow continues to assert that Uppaluru does not teach what the Office agrees that it teaches. Claim 28 is therefore deemed allowable over the combination.

If an independent claims is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious." MPEP § 2143.033 quoting *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). In view of their dependence from an allowable parent, Claims 29-30 are deemed allowable without any separate consideration of their merits.

Uppaluru Does Not Teach or Suggest “Applying One or More Text Patterns to a Web Page to Identify said Information and Extract it; Applying a Plurality of Rules to said Information to Construct Grammatical Sentences from said Information.”

Claim 33:

Claims 33-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of United States patent no. 5,799,063 to Krane, *et al.* (“Krane”) and United States patent no. 6,400,806 to Uppaluru, *et al.* (“Uppaluru”). Appellant respectfully disagrees

The Office again asserts that Uppaluru teaches or suggests the Claim element, “Applying one or more text patterns to a web page to identify said information and extract it”, relying on col. 3, lines 30-65. Appellant respectfully disagrees. Although the Office again fails to provide any explanation or analysis of its application of the citation to the Claim language, it appears that the Office is relying on Uppaluru’s “speaker dependent word patterns” as teaching or suggesting the application of text patterns. However, as described at col. 2, lines 47 to col. 3, line 5, the speaker dependent voice patterns are not text patterns at all. Rather, they are part of the “speech training profile” which the ordinarily-skilled practitioner would understand to be one or more speech samples recorded by the user in order to “train” the system. These samples, or speaker dependent voice patterns, are recorded as audio files and associated with key words such as voice browser commands, as described at col. 24, lines 1-23 and col. 26, line 8 to col. 27, line 6. When the user makes an utterance, the utterance is matched with one of the recorded speech snippets, and the associated browser command is executed. There is therefore no teaching or suggestion in Uppaluru of text patterns or of applying one or more text patterns to a web page to identify said information and extract it.

Next, the Office cites Uppaluru, col. 12, lines 3-5 as teaching or suggesting “applying one or more text patterns to a web page to identify said information and extract it; applying a plurality of rules to said information to construct grammatical sentences from said information.” Appellant respectfully disagrees. The citation describes the playing of email messages for the subscriber using text-to-speech conversion technology and a speech

synthesizer. No details of the text-to-speech conversion are given. The only teaching regarding text-to-speech technology is at col. 8, lines 32-33, describing that voice prompts identified by HVML tags can be generated using text-to-speech technology. Because the whole of Uppaluru is completely silent as to the details of the purported text-to-speech technology, it is fanciful to propose that the three lines of the col. 12 citation teach or suggest each they teach or suggest:

“applying one or more text patterns to a web page to identify said information and extract it”.

Additionally, although there is no mention of rules, or applying rules to data extracted from web pages, the Office maintains that the reference teaches or suggests:

“Applying a plurality of rules to said information to construct grammatical sentences from said information.”

In fact, there is no mention anywhere in Uppaluru that rules be applied to extracted information to construct grammatical sentences from the information. Again, the Office seems to pull the teaching or suggestion from thin air based on the mention of text-to-speech conversion in the col. 12 citation. However, no such subject matter is mentioned or suggested. There is no reason to think that a text-to-speech conversion of email uses a rule-based approach to generating grammatical sentences from raw information. The text-to-speech conversion simply renders as speech whatever the text says. If the text happens to be in grammatical sentences, the resulting speech will be in the form of grammatical sentences. If the underlying text is gibberish, so will the generated speech be gibberish.

The present rejection of Claim 33 is improper because the Office has failed to show that the combination teaches or suggests each and every element of Claim 33. Claim 33 is therefore deemed allowable over the combination. In view of their dependence from an allowable parent Claim, Claims 34-35 are deemed allowable without any separate consideration of their merits.

OTHER GROUNDS OF REJECTION

None.

CONCLUSION

In view of the foregoing, and with reference to Appellant's brief and the record herein, Appellant respectfully submits that the Office is in error as to the rejections under 35 U.S.C. § 112. Additionally, the Office is in error as to the question of whether the cited combination of references teaches or suggests the subject matter of the Claims. At the very least, substantial elements of the claimed invention are not shown anywhere in any of the references, either alone or in combination. Furthermore, the combination teaches away from the Claimed subject matter. As such, there is nothing to motivate a person skilled in the art to combine the references as asserted by the Office. Accordingly, Appellant respectfully requests that the Board favorably receive Appellant's remarks and reverse the Office's findings.

The Commissioner is authorized to charge any additional fees or credit any overpayments to Glenn Patent Group Deposit Account 07-1445.

Respectfully submitted,



Michael A. Glenn

Reg. No. 30,176

Customer No: 22862